Customer No. 24498

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants:	**Daniel Scheidewend, et al.**
Serial Number:	**09/445,268**
Atty. Docket:	**RCA 89,068**
Filing Date:	**April 3, 2000**
For:	**SYSTEM AND METHOD FOR COORDINATING USER ACTIONS**
Art Unit:	**2623**
Examiner:	**Michael Van Handel**

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Examiner's Answer dated September 6, 2007, Appellants hereby submit a Reply Brief in accordance with 37 C.F.R. §41.41 for the above-referenced application.

Response to Examiner's Answer

In response to the Examiner's Answer of September 6, 2007, Appellants maintain that claims 16-18, 20, 22 and 24 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,850,218 issued to LaJoie et al. (hereinafter, "LaJoie"), and claims 19, 21, 23 and 25 are patentable under 35 U.S.C. §103(a) over LaJoie in view of the RCA DRD202RA Owner's Manual.

In the Examiner's Answer dated September 6, 2007, the Examiner continues to allege that the "conflict checking feature" of LaJoie described on column 21, line 30 to column 22, line 5 serves as the basis for rendering the claimed invention obvious under 35 U.S.C. §103(a). In describing the types of conflicts that may arise, LaJoie states:

> "Conflicts can arise, for example, when there are overlapping timers, unusual settings (such as VCR record timers which exceed typical tape length), record timers for unpurchased Impulse Pay-Per-View (IPPV) events, attempts to set up more than a limiting number of VCR timers (e.g., eight), and attempts to purchase more than a limiting number of IPPV events (e.g., eight)." (see column 21, lines 35-42)

As indicated above, LaJoie expressly describes only a limited number of conflict situations. On page 18 of the Examiner's Answer, the Examiner acknowledges that LaJoie specifically provides two particular examples for resolving conflicts. First, LaJoie addresses a first conflict that occurs when a user attempts to record an IPPV event (see column 21, lines 42-49), and addresses a second conflict that occurs when there are overlapping timers (see column 21, line 49 to column 22, line 5). As pointed out in Appellants' previously submitted Appeal Brief, this conflict checking feature of LaJoie fails to address the problems associated with the lack of coordination between performing program purchases and program recordings in the manner specified by the claimed invention. Despite this deficiency of LaJoie, however, the Examiner (using hindsight) continues to allege that the conflict checking feature of LaJoie could be modified by one of ordinary skill in the art to meet the elements of the claimed invention, and thereby concludes that LaJoie renders the claimed invention obvious under 35 U.S.C. §103(a).

In response, Appellants note that the Examiner's application of the Graham factors is clearly based on impermissible hindsight, and fails to fully consider a key requirement for obviousness under 35 U.S.C. §103(a), namely that the prior art suggests the desirability of the proposed modifications. As previously indicated, the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, Appellants maintain that LaJoie fails to teach or suggest the desirability of the inventions defined by independent claims 16-18, 20, 22 and 24.

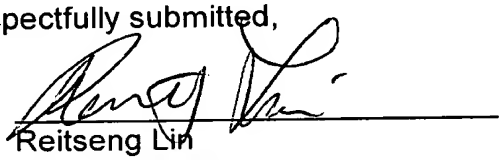
First, as indicated in Appellants' previously submitted Appeal Brief, independent claims 16, 18 and 22 define a method/apparatus in which a program (i.e., the "second program") is automatically removed from a list of programs scheduled for recording (i.e., the "first list") in response to user removal of the program from a list of programs selected for purchase (i.e., the "second list"). In this manner, independent claims 16, 18 and 22 advantageously provide coordination between performing program purchases and program recordings by automatically removing a program (i.e., the "second program") from a list of programs scheduled for recording (i.e., the "first list") in response to user removal of the program from a list of programs selected for purchase (i.e., the "second list").

Secondly, as indicated in Appellants' previously submitted Appeal Brief, independent claims independent claims 17, 20 and 24 define a method/apparatus in which an on screen display option is provided so that a user is afforded an opportunity to cancel the purchase of a program in response to the user canceling a scheduled recording of the program. In this manner, independent claims 17, 20 and 24 advantageously provide coordination between performing program purchases and

program recordings by giving a user an opportunity to cancel the purchase of a program in response to the user canceling a scheduled recording of the program.

Appellants further note that the aforementioned "conflict checking feature" of LaJoie does not teach or suggest the desirability of the inventions defined by independent claims 16-18, 20, 22 and 24, as required for an obviousness rejection under 35 U.S.C. §103(a). As indicated above, the "conflict checking feature" of LaJoie expressly describes only a limited number of conflict situations. Moreover, none of these conflict situations of LaJoie suggest a solution that advantageously provides coordination between performing program purchases and program recordings in the manner defined by independent claims 16-18, 20, 22 and 24. As such, Appellants submit that the instant rejections are simply the product of impermissible hindsight reconstruction based on teachings gleaned from the Appellants' disclosure, and from improperly filling-in the missing gaps of the prior art in an attempt to meet the elements of the claimed invention. Accordingly, Appellants respectfully request that the Board reverse the rejection of claims 16-25, and that this application be passed to issue. Please charge any fee due for this Reply Brief to Deposit Account 07-0832.

Respectfully submitted,



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November 2, 2007

CERTIFICATE OF MAILING

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop Appeal Brief, Commissioner for Patents, Alexandria, Virginia 22313-1450 on:

November 2, 2007 — Lori Klein
Date